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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/716,918

11/20/2000

Jay S. Walker

98-010-C1

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7590

01/05/2011

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EXAMINER

LEIVA, FRANK M

ART UNIT

PAPER NUMBER

3717

MAIL DATE

DELIVERY MODE

01/05/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. WALKER, JAMES A. JORASCH, and
MAGDALENA MIK

Appeal 2009-009986
Application 09/716,918
Technology Center 3700

Before JOHN C. KERINS, MICHAEL W. O'NEILL, and KEN B.
BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Jay S. Walker et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 50-54, 56-58, 60-62, 64-69, and 71-77 under 35 U.S.C. § 102(e) as being anticipated by Barrie (US 5,833,537, issued Nov. 10, 1998), claims 55, 59, and 63 under 35 U.S.C. § 103(a) as being unpatentable in view of Barrie and Weiss (US 6,165,071, issued Dec. 26, 2000), and claim 70 as being unpatentable in view of Barrie alone.² We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The Invention

The claims on appeal relate to a gaming machine having the ability to determine a bonus payout based on a running count of tracked symbol occurrences. Spec. 1: 6-8.

Claim 50, reproduced below, is illustrative of the subject matter on appeal.

50. A method comprising:
generating an outcome represented by a plurality of symbols;
counting occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition;
determining whether the number is at least a minimum number; and

² While Appellants appealed all the claims pending, Appellants do not separately address the rejection of claims 55, 59, and 63. This is understandable since the Examiner omitted listing the grounds of rejection in the Final Office Action, mailed Jan. 8, 2008; *cf.* Ans. 2 (confirming that Appellants' statement of the grounds of rejection on appeal (App. Br. 13, which does not list the rejection of claims 55, 59, and 63) is correct). Appellants' omission does not effect our disposition of this appeal.

providing, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol,

wherein the expiration condition defines at least one of

(i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires and

(ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires, and further

wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time.

DISCUSSION

We agree with Appellants that the Examiner has failed to establish that claims 50-54, 56-58, 60-62, 64-69, and 71-77 lack novelty inasmuch as the Examiner has failed to identify where all of the claimed limitations are disclosed within one embodiment of Barrie. Instead, the Examiner's rejection and response "picks and chooses" features from multiple embodiments that are not disclosed as working together, but rather are alternative embodiments, and misconstrues Barrie's disclosure in order to improperly attribute the Appellants' claimed terminology to Barrie's disclosure. Thus, the Examiner's anticipation rejection is based on the building of an improper foundation with an inappropriate framing to bolster an unsupportable "argument" for anticipation.

The Examiner fails to remedy the aforementioned error within the obviousness rejections.

Appeal 2009-009986
Application 09/716,918

DECISION

Based on the foregoing, the Examiner's decision to reject the claims pending on appeal is reversed.

REVERSED

Klh

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